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a browser window, and is not concerned with displaying a program along with a program guide listing the title of the program. Similarly, the relied-upon portion of Gerba is not directed to showing TV programming on a browser but only to providing a convenient way for a viewer to see a program at the same time he can also see the title of the program without having to move his eyes, Gerba, *id.* Accordingly, since Anderson et al. admittedly does not contemplate a transparent section of the browser and since Gerba is directed to a different problem than both Anderson et al. and the present claims, and does not suggest its transparency concept for use in a browser-based environment, there is no proper prior art suggestion to combine the references as proposed.

With greater specificity, more is required in satisfying the MPEP than an observation that the proposed modifications "would have been obvious to one skilled in the art". Rather, in seeking to establish a *prima facie* case of obviousness, it must be identified where the *prior art* provides a motivating suggestion to make the modifications proposed, *In re Jones*, cited at MPEP §2143.01. In other words, the required suggestion, whether express or implied, must nevertheless be particularly found in the *prior art*, not the Examiner's sagacity ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the *prior art*" *In re Fine*, *id.* The mere fact that a reference can be modified does not render an invention obvious, unless the modification is suggested by the *prior art*, *In re Mills*, *id.* Indeed, the motivation to combine references requires a showing from the *prior art* of what is **desirable**, not merely what is feasible, *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000), and here, Gerba nowhere teaches or suggests in the relied-upon portion that its transparency concept is feasible, much less desirable, in a browser.

Looked at another way, even if the references were combined in some unsuggested fashion, the present claims would not result. Instead, an odd combination flowing from the teachings of the references

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would be produced wherin a TV window would be superimposed over a Web browser display as taught by Anderson et al., and then, presumably in another window, a TV program would appear in a transparent portion of a program guide *sans* browser as taught by Gerba. In any case, the present claims would not result.

In addition, "to render a later invention unpatentable for obviousness, the prior art must enable the later invention", noting that the question wasn't whether the prior art enabled itself but rather whether it enabled the invention being rejected, *In re Kumar*, 418 F.3d 1361 (Fed. Cir. 2005). Here, since the relied-upon section of Gerba says nothing about browsers, it cannot enable using its transparent portion in a browser, further militating toward patentability of the present claims.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,


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